

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Docket Number (Optional)

200308699-1

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on \_\_\_\_\_

Signature \_\_\_\_\_

Typed or printed  
name \_\_\_\_\_

Application Number

10/669,822

Filed

09/24/2003

First Named Inventor

Jerry G. AGUREN

Art Unit

2163

Examiner

M. F. Nguyen

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)☒ attorney or agent of record. 43,100  
Registration number \_\_\_\_\_☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

  
Signature

Mark E. Scott

Typed or printed name

(713) 238-8000

Telephone number

10/23/2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.  
Submit multiple forms if more than one signature is required, see below\*.

☒ \*Total of one (1) forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant:	Jerry G. AGUREN	§	Confirmation No.:	5688
		§		
Serial No.:	10/669,822	§	Group Art Unit:	2163
		§		
Filed:	09/24/2003	§	Examiner:	M. F. Nguyen
		§		
For:	Method and System for	§	Docket No.:	200308699-1
	Implementing Storage	§		
	Strategies of a File	§		
	Autonomously of a User	§		

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

**Mail Stop AF**

Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

Date: October 23, 2006

Appellant hereby submits this Pre-Appeal Brief Request for Review in connection with the above-identified application. A Notice of Appeal is filed concurrently herewith.

Appellant respectfully submits that the final Office action dated September 22, 2006 contains omissions of one or more essential elements needed for *prima facie* rejections.

The Office action rejects claim 1 as allegedly failing to comply with the written description requirement under 35 USC 112, first paragraph. In order to present a *prima facie* shortcoming of written description, the Office action must assert that one having ordinary skill would not gather from the specification that Appellant was in possession of the claimed invention as of the filing date.

To satisfy the written description requirement, an applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention, and that the invention, in that context, is whatever is now claimed.

(MPEP 8<sup>th</sup> Ed. Rev 3, August 2005, § 2163, p. 2100-172). The written description rejection at issue here is **of an original claim, not an amended or new claim**, and the MPEP further notes that "[t]here is a strong presumption that an adequate

written description of the claimed invention is present." (MPEP 8<sup>th</sup> Ed. Rev. 3, August 2005, § 2163, p. 2100-173). Further, this is not a case where the limitation is present in the claim but not in the specification. In fact, the Office action admits that the limitation at issue is found throughout the specification. "The specification keep [sic] repeating the term 'autonomous of the user'." (Office action, p. 2, Paragraph 2).

The Office action fails to make a *prima facie* showing of a written description shortcoming. Rather than assert that one skilled in the art would not gather from the specification that Appellant was in possession of the claimed invention as of the filing date, the Office action merely asserts that the written description rejection is proper because the Examiner cannot identify relevant prior art.

Claim 1 recites the term "autonomous" which is not described in the specification in search [sic such] a way that the Examiner can rely on for relevant prior art.

(Office action, p. 2, Paragraph 2).<sup>1</sup> Appellant respectfully submits that the Office action applies an incorrect test, and thus fails to make a *prima facie* showing. The test is not whether there is sufficient description "that the Examiner can rely on for relevant prior art"; but rather, whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention.

The Office action also rejects claim 1 as allegedly indefinite under 35 USC 112, second paragraph. In particular, the Office action asserts:

[T]he recitation of "the recitation of appearing to operate in the client machine namespace and in the client machine file structure" is vague and indefinite because it's unclear what Applicant means of [sic by] "the receiving by appearing to operate."

(Office action of September 22, 2006, Page 3, first full paragraph). The limitation of claim 1 at issue reads in its entirety:

receiving a file from a client machine, the receiving by appearing to operate in the client machine namespace and in the client machine file structure;

---

<sup>1</sup> The Office action does, however, present rejections, including cited prior art, in spite of this alleged inability.

Clearly the phrase "the receiving by appearing..." is meant to modify the receiving step, and thus indefiniteness rejection is misplaced.

The Office action of September 22, 2006 also rejects claim 1 as allegedly being directed to non-statutory subject matter. According to the MPEP, descriptive material comes in two varieties: functional descriptive material; and non-functional descriptive material. (MPEP 8<sup>th</sup> Ed. Rev. 3, August 2005, § 2106(IV)(B)(1), pp. 2100-11, 12).

'[F]unctional descriptive material' consists of data structures and **computer programs** which impart functionality when employed as a computer component.

(*Id.* (emphasis added)).

When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized.

(*Id.*). One does not merely look at the claim language when evaluating considerations under Section 101; rather, the claimed invention as a whole must be evaluated.

Each invention must be evaluated as claimed; yet semantogenic considerations preclude a determination based solely on words appearing in the claims. In the final analysis under 101, the claimed invention, as a whole, must be evaluated... .

(*Id.*).

Claim 1 (and its dependents) are directed to a "computer readable medium storing a program that, when executed by a processor, performs a method." Thus, claim 1 is not directed to a method as asserted by the Office action, but is directed to a physical object (computer readable medium) storing functional descriptive material in the form of a computer program. For this reason alone the Section 101 rejection should be withdrawn.

Moreover, the Office action of September 22, 2006 improperly focuses solely on the claim terminology in evaluating usefulness. However, as noted above it is not the claim language viewed in a vacuum that forms the basis of the

usefulness determination; but rather, the claimed invention as a whole is evaluated for usefulness under Section 101. Thus, the Office action applies an improper test, focusing solely on the claim limitations, when evaluating whether the invention produces a "useful, concrete and tangible result." For this additional reason the Section 101 rejection should be withdrawn.

Claim 1-14 and 19-25 stand rejected in whole or in part over Cannon. However, Cannon is missing an element needed for a *prima facie* showing in each of these rejections. In particular, in Cannon smaller files are aggregated into larger files to reduce associated overhead. When the smaller files are in aggregate form, the constituent files are still tracked by their originally assigned file name.

Claim 1, by contrast, specifically recites, "implementing ... storage strategies for the file based on the metadata and **in a namespace different than the client machine name space.**" It appears in the Cannon system the namespace of the aggregate file is the same as the original system; moreover, the constituent smaller files are tracked within the aggregate file by their original name. Thus, Cannon (alone or in combination with the other cited art) fails to teach "implementing **in a namespace different than the client machine name space.**" The rejections of independent claims 8 and 19 (and their dependents) have a similar shortcoming.

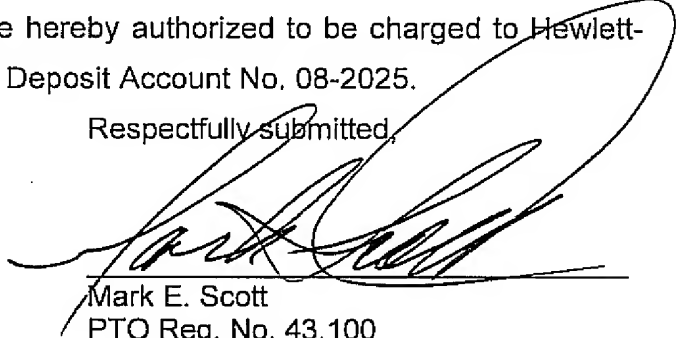
Finally, claims 15-18 are rejected as allegedly anticipated by Mikesell. However, Mikesell is missing an element needed for a *prima facie* showing in each of these rejections. In particular, Mikesell discloses a system where data files are stored and accessed as a standard file system, but where blocks of each file are distributed across multiple storage units.

Claim 15, by contrast, specifically recites, "the server stores the file on at least one of the first and second storage devices in a global namespace ... ." In Mikesell, data files are stored and accessed as a standard file system, with blocks of each file distributed across multiple storage units. Thus, Mikesell fails to expressly or inherently contain a teaching of "wherein the server appears to programs executing on the client computer as a network storage device **operating in a user namespace and in a user file structure**; and **wherein the server**

**stores the file on at least one of the first and second storage devices in a global namespace ... ."**

Appellant respectfully requests reconsideration and that a timely Notice of Allowance be issued in this case. It is believed that no extensions of time or fees are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required (including fees for net addition of claims) are hereby authorized to be charged to Hewlett-Packard Development Company's Deposit Account No. 08-2025.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Mark E. Scott', is written over a horizontal line. The signature is stylized with a large, sweeping loop at the end.

Mark E. Scott  
PTO Reg. No. 43,100  
CONLEY ROSE, P.C.  
(713) 238-8000 (Phone)  
(713) 238-8008 (Fax)  
ATTORNEY FOR APPELLANT

HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
Legal Dept., M/S 35  
P.O. Box 272400  
Fort Collins, CO 80527-2400